

JIMENEZ ET AL. -- 09/852,051  
 Client/Matter: 081427-0278455

### REMARKS

Reconsideration and allowance are respectfully requested in view of the following remarks.

Upon entry of our Amendment filed on November 7, 2003, claims 1-41 are pending in the application.

#### Declaration Traversing Rejection Under 37 C.F.R. 1.132

Applicants submit herewith a Declaration Under Rule 132 traversing the outstanding rejections. Such a Declaration "must be considered by the examiner in determining the issue of obviousness," and the "evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness." M.P.E.P. 706.01(a).

The Rule 132 Declaration submitted herewith includes evidence of the professional approval of the commercial embodiment of the subject invention. In particular, the subject Rule 132 Declaration discloses that in 2002 the commercial embodiment of the subject invention received an Industrial Design Excellence Award (IDEA) from the Industrial Designers Society of America. (The IDEA awards are sponsored by *BusinessWeek* magazine.) The subject straightedge was selected to receive one of the IDEA awards from more than 1116 new products that were reviewed by a jury of experts. Such professional approval of the subject straightedge is noteworthy with respect to the outstanding rejections as evidence supporting patentability. "Praise for the invention, including awards accorded to the inventors for their invention, are further evidence of the novelty and worth of the inventions." *Corning Glass Works v. Sumitomo Electric USA Inc.*, 5 U.S.P.Q.2d 1545 (SDNY 1987) (citing *Rosemount, Inc. v. Beckman Instruments, Inc.*, 221 U.S.P.Q. 1 (Fed. Cir. 1984)), *aff'd*, 9 U.S.P.Q.2d 1962 (Fed. Cir. 1989).

In the subject Rule 132 Declaration, the commercial embodiment of the subject straightedge is illustrated and a brief explanation providing reasons for granting the award is found in the Fall 2002 issue of *Innovation*, the quarterly magazine of the Industrial Designers Society of America (Exhibit B of the Declaration). *Innovation* shows a photo of the commercial embodiment of the straightedge, which includes all of the limitations of, at least, the rejected independent claims 1, 13 and 21. Additionally, *Innovation* states that the commercial embodiment of the subject invention "improves upon the standard yardstick. Clamped to a surface or gripped the center rib it can be used as a guide for an electric saw or knife blade." Thus, there exists a clear nexus between the claim limitations and the granting

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of the award. Accordingly, the granting of an award to the commercial embodiment of the claimed guiding device and the professional approval it signifies further supports the nonobviousness of the claimed invention.

Based on our Amendment filed November 7, 2003, and the Rule 132 Declaration that establishes an important secondary factor of non-obviousness, namely commercial success, it is respectfully requested that the obviousness rejection made against claims 1, 13, and 21 be withdrawn.

\* \* \* \*

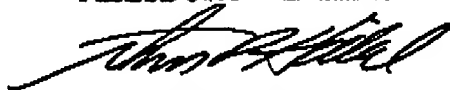
It is respectfully submitted that the present application is in condition for allowance, and a notice to that effect is earnestly solicited.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Should there be any questions or concerns regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,

PILLSBURY WINTHROP LLP



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TPH/ml

Attachments: Rule 132 Declaration (including Exhibits A-C)

### ***CERTIFICATE OF FACSIMILE TRANSMISSION***

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Name Thomas P. Hilliard

Sig. 

Date November 26, 2003

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